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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,075	09/30/2003	Brent Dalmas Nelson	93-03-015	5074

34279 7590 05/16/2006

DOCKET CLERK, DM/EDS  
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EXAMINER
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COUGHLAN, PETER D

ART UNIT	PAPER NUMBER
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2129

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/675,075	<b>Applicant(s)</b> NELSON ET AL.	
	<b>Examiner</b> Peter Coughlan	<b>Art Unit</b> 2129	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/5/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## Detailed Action

1. Claims 1-20 are pending in this application.

### ***Specification Rejections***

2. The specification is rejected to due to the following. Claims 2 and 11 uses the term "internal consistency". This could have a number of meanings but none are addressed or explained in the specification.

The specification is rejected to due to the following. Claims 6 and 15 uses the term "higher order". Implies some sort of levels but none are addressed or explained in the specification.

The specification is rejected to due to the following. Claims 7 and 16 uses the term "enterprise documents". This could have a number of meanings but none are addressed or explained in the specification.

Per the MPEP, section 608.01(I) the claim(s) is/are treated on its merits and a requirement made to amend the drawing and description to show the subject matter.

**35 USC § 101**

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 for nonstatutory subject matter.

The computer system must set forth a practical application of that § 101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77. The invention is ineligible because it has not been limited to a substantial practical application. A method for generating an intellectual capital management system has no practical application. There needs to be a reason for such an application.

In determining whether the claim is for a “practical application,” the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is “useful, tangible and concrete.” If the claim is directed to a practical application of the § 101 judicial exception producing a result tied to the physical world that does not preempt the judicial exception, then the claim meets the statutory requirement of 35 U.S.C. § 101.

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Extracting information, correlating information, generating synonym links between them, integrating links into a taxonomy design, and exporting the final result is nothing more than an exercise in cataloging information.

The invention must be for a practical application and either:

- 1) specify transforming (physical thing) or
- 2) have the FINAL RESULT (not the steps) achieve or produce a  
useful (specific, substantial, AND credible),  
concrete (substantially repeatable/ non-unpredictable), AND  
tangible (real world/ non-abstract) result.

A claim that is so broad that it reads on both statutory and non-statutory subject matter, must be amended, and if the specification discloses a practical application but the claim is broader than the disclosure such that it does not require the practical application, then the claim must be amended.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-4, 7-13, 16-19 are rejected under 35 U.S.C. 102(e) (hereinafter referred to as **Schmitz**) being anticipated by Schmitz et al., U.S. Patent Publication 20030149567.

Claims 1, 10, 19.

Schmitz anticipates extracting a plurality of local taxonomies from the plurality of local enterprise community models (**Schmitz**, ¶0037); correlating from each of said plurality of local taxonomies a set of topics and a set of associations for generating a correlated topics and associations set relating to each of said plurality of local taxonomies (**Schmitz**, ¶0029; 'Topics' of applicant is equivalent to 'category' of Schmitz.); deriving a plurality of synonym links for linking synonyms within said correlated topics and associations set (**Schmitz**, ¶0027 and ¶0029; 'Natural language' taxonomy can be used to make 'synonym links' of the 'attribute value' ( a superset of category) of Schmitz.) ; integrating said plurality of synonym links and said correlated topics and associations set into an integrated enterprise taxonomy (**Schmitz**, ¶0038; 'Integrating' of applicant is equivalent to 'taxonomy database' of Schmitz. At this point all synonym links and attribute vales are linked together in a standard template form.) ; and exporting said integrated enterprise taxonomy into said intellectual capital management system. (**Schmitz**, ¶0039; 'Exporting said integrated enterprise taxonomy' of applicant is equivalent to 'attribute-value composite string may be generated' of Schmitz.)

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Claims 2, 11.

Schmitz anticipates determining internal consistency within each of said plurality of local taxonomies. (**Schmitz**, abstract; 'Determining internal consistency' of applicant is preformed by the 'analytics system' of Schmitz.)

Claims 3, 12.

Schmitz anticipates forming said correlated topics and associations set as a metamodel system (**Schmitz**, ¶0029; 'Metamodel' of applicant is equivalent to 'attributes' of Schmitz. Each attribute consists of 'category' (equivalent to topic), 'page' and 'instant'.); and constituting said set of topics and associations to be correlated as relationships within said metamodel system. (**Schmitz**, ¶0029; The generation of the 'attributes' illustrates the correlation of relationships of the elements of the attributes within itself.)

Claims 4, 13.

Schmitz anticipates exporting said integrated enterprise taxonomy into said intellectual capital management system as a plurality of comma-separated-value files comprising said synonym links and said correlated topics and association set. (**Schmitz**, ¶0049; 'Comma-separated value files' of applicant is equivalent to 'concatenation' of the 'string' of Schmitz.)

Claims 7, 16.

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Schmitz anticipates associating said integrated enterprise taxonomy with a plurality of enterprise documents associated with said intellectual capital management system. (**Schmitz**, ¶0005; 'Enterprise document' of applicant is equivalent to 'HTML document' of Schmitz.)

Claims 8, 17.

Schmitz anticipates forming said integrated enterprise taxonomy as a metamodel system associated with said intellectual capital management system. (**Schmitz**, abstract; 'Intellectual capital' of applicant is equivalent to 'data requested' and/or additional instructions' of Schmitz.)

Claims 9, 18

Schmitz anticipates forming said integrated enterprise taxonomy as a database associated with said intellectual capital management system. (**Schmitz**, ¶0050; 'Forming' of applicant is equivalent to 'stored in the taxonomy database' of Schmitz.)

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 6, 14, 15, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmitz as set forth above in view of Bernstein (U. S. Patent Publication 20030120651, referred to as **Bernstein**)

Claims 5, 14, 20.

Schmitz fails to particularly call for forming said correlated topics and associations set as a hierarchical tree structure within a metamodel system; and forming said set of topics as node objects within said hierarchical tree structure; and forming said set of associations as relationships between said node objects within said hierarchical tree structure.

Bernstein teaches forming said correlated topics and associations set as a hierarchical tree structure within a metamodel system (**Bernstein**, ¶0049); and forming said set of topics as node objects within said hierarchical tree structure; and (**Bernstein**, ¶0188; 'Topics' of applicant is equivalent to 'subject' of Bernstein.) forming said set of associations as relationships between said node objects within said hierarchical tree structure. (**Bernstein**, ¶0179; The 'relationship' between nodes of applicant is illustrated by the variable 'IsDerivedFrom' of Bernstein.) It would have been obvious to a person having

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ordinary skill in the art at the time of applicant's invention to modify the teachings of Schmitz by designing the structure as a hierarchical tree, using topics as a basis of classification and generating a association of relationships as taught by Bernstein to form said correlated topics and associations set as a hierarchical tree structure within a metamodel system; and forming said set of topics as node objects within said hierarchical tree structure; and forming said set of associations as relationships between said node objects within said hierarchical tree structure.

For the purpose of using an established organizational method for classifying information into related groups with a narrower domain as one traverses the tree structure.

Claims 6, 15.

Schmitz fails to particularly call for forming with said synonym links a canonical synonym link structure associated with a canonical synonym from among said synonyms, said canonical synonym link structure for associating non-canonical synonyms with said canonical synonym, said canonical synonym possessing a higher order than other ones of said synonyms.

Bernstein teaches forming with said synonym links a canonical synonym link structure associated with a canonical synonym from among said synonyms, said canonical synonym link structure for associating non-canonical synonyms with said canonical synonym, said canonical synonym possessing a higher order than other ones of said synonyms. (**Bernstein**, ¶0012) It would have been

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obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Schmitz by using a canonical link structure to form synonym links as taught by Bernstein to form with said synonym links a canonical synonym link structure associated with a canonical synonym from among said synonyms, said canonical synonym link structure for associating non-canonical synonyms with said canonical synonym, said canonical synonym possessing a higher order than other ones of said synonyms.

For the purpose of using only one term along with an infusion of logic to produce the canonical synonym.

### ***Conclusion***

6. The prior art of record and not relied upon is considered pertinent to the applicant's disclosure.

-U. S. Patent Publication 20030120653: Brady

-U. S. Patent 5845049: Wu

-U. S. Patent 6311194: Sheth

-U. S. Patent 6233575: Agrawal

-U. S. Patent Publication 20030126151: Jung

-U. S. Patent 6606613: Altschuler

-U. S. Patent Publication 20030126136: Omoigui

-U. S. Patent Publication 20020161626: Plante

-U. S. Patent Publication 20020125618: Maes

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-U. S. Patent 6311194: Sheth

7. Claims 1-20 are rejected.

***Correspondence Information***

8. Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner Peter Coughlan, whose telephone number is (571) 272-5990. The Examiner can be reached on Monday through Friday from 7:15 a.m. to 3:45 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor David Vincent can be reached at (571) 272-3687. Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,  
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(571) 273-8300 (for formal communications intended for entry.)

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).



Peter Coughlan

5/8/2006

